

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS P. MORAN, PATRICK CHIU and WILLIAM VAN MELLE

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Appeal No. 2000-0963  
Application No. 08/736,883

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ON BRIEF

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Before HAIRSTON, KRASS and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3, 20-23, 57-84 and 86-104, which constituted all the claims remaining in the application. A first amendment after final rejection was filed on March 26, 1999 but was denied entry by the examiner. A second amendment after final rejection was filed concurrently with the appeal brief on September 9, 1999. This amendment was entered by the examiner. This amendment cancelled claims 2, 3, 21-23, 60 and 61. Therefore,

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this appeal is directed to the rejection of claims 1, 20, 57-59, 62-84 and 86-104.

The invention is directed to a display-oriented graphical editing system which allows for inputting and editing of data in the form of informal scribbling in handwriting and sketches, and inputting of ASCII characters. The invention permits unstructured freeform data to be entered, and the type of data structure does not have to be identified until an editing operation is to be performed on the data.

Representative claim 1 is reproduced as follows:

1. A display-oriented graphical editing system which allows for inputting and editing of data in the form of informal scribbling in handwriting and sketches, and inputting and editing of ASCII characters, the system comprising:

a substantially uniformed unlined display;

means for entering the data, which is unstructured freeform data, anywhere on said unlined display; wherein the structure of said displayed data is undetermined at the time of their entry;

means for selecting an editing operation from among a plurality of editing operations to be performed on at least a portion of said displayed data, the editing operations capable of being performed including selectively editing of script, ASCII and diagrams;

means for designating said portion of said displayed data as at least one particular data structure before performing said editing operation; wherein the at least one particular data structure of said selected portion of said displayed data may be changed after performing said editing operation; and

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means for performing said editing operation on said selected portion of said displayed data; wherein the operability of said editing operation is independent of the location of said selected portion of said displayed data, and said editing operations include line-wrapping of the script and ASCII characters entered on the unlined display when the one particular data structure is a text data structure.

The examiner relies on the following references<sup>1</sup>:

Forcier (Forcier '649)	5,220,649	June 15, 1993
Forcier (Forcier '698)	5,231,698	July 27, 1993

Claims 1 and 89-91 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention. Claims 1, 57-59, 62-84 and 86-104 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Forcier '649. Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Forcier '649 and Forcier '698.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, the arguments in support

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<sup>1</sup> The examiner's answer cites an additional reference to Sato et al., but the incorporated final rejection does not refer to this reference anywhere in the rejection.

of the rejections and the evidence of obviousness relied upon by the examiner as support for the obviousness rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that claims 1 and 89-91 particularly point out the invention in a manner which complies with 35 U.S.C. § 112. We are also of the view that the prior art evidence relied upon does not support either of the prior art rejections as formulated by the examiner. Accordingly, we reverse.

We consider first the rejection of claims 1 and 89-91 under the second paragraph of 35 U.S.C. § 112. The examiner's rejection states the following:

In claim 1 and claim 89, the phrase 'the data, which is' is not correct [final rejection, page 2, incorporated into answer].

Appellants argue that the objected to language is appropriately set forth as a parenthetical clause [brief, pages 10-11].

The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as

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it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

We agree with appellants that the artisan would have no difficulty ascertaining the scope of the invention recited in claims 1 and 89-91. The phrase "[means for] entering the data, which is unstructured freeform data" in claims 1 and 89 clearly means the exact same thing as the phrase "[means for] entering unstructured freeform data" which is used, and not objected to, in other claims on appeal. Therefore, the rejection of claims 1 and 89-91 under the second paragraph of 35 U.S.C. § 112 is not sustained.

We now consider the rejection of claims 1, 20, 57-59, 62-84 and 86-104 under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1,

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17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048,

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1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

The examiner indicates how he finds the claimed invention to be obvious over the teachings of Forcier '649 [final rejection, pages 3-17, incorporated into examiner's answer]. With respect to each of the claims on appeal, appellants argue that the examiner's findings are not supported by the disclosure of Forcier '649 [brief, pages 11-40]. The examiner breaks down appellants' arguments into three key arguments, and the examiner indicates his disagreement with these three arguments [answer, pages 4-6]. Appellants respond that the examiner's findings are incorrect and unsupported [reply brief].

We agree with the position argued by appellants. Since appellants have addressed the examiner's incorrect findings in great detail, and since we agree with appellants' arguments, we will not detail the extensive arguments again in this decision. We simply note that we agree with all of appellants' arguments set forth in the briefs, and based on these arguments, the examiner's rejection, as formulated, does not establish a prima facie case of

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obviousness. Therefore, we do not sustain the rejection of any of the appealed claims under 35 U.S.C. § 103.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 20, 57-59, 62-84 and 86-104 is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
ERROL A. KRASS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JERRY SMITH	)	
Administrative Patent Judge	)	

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Albert P. Sharpe, III  
Fay, Sharpe, Beall, Fagan, Minnich  
& McKee  
1100 Superior Ave., Ste. 700  
Cleveland, OH 44114-2518